

REMARKS

Claims 13-14, 33-34, 56, 67, 118-20 and 122-32 were presented for examination and were rejected. Solely to avoid further expense, the claims have been amended as follows.

Solely to avoid the expense of an appeal, claims 13 and 120 have now been canceled from this application. The Applicant reserves the right to present those claims in a later application.

Claim 14 has been amended to indicate that the binding partner is on the surface of the microdevice. Claim 14 has also been split into two claims: one of its alternative embodiments remains as claim 14, and the other has been presented as a separate independent claim, new claim 133. Additional dependent claims 134-139, corresponding to claims 33-34, 56, 67, and 112-119, have been added, and they depend from claim 133. Claims 14 and 133 were identified as allowable but for the alleged indefiniteness issue, which is overcome by the amendment. The claims depending from them are also allowable in view of the amendment of claim 14.

Claims 120 has been canceled, and its limitations have been added into claim 122, which previously depended from claim 120. Claim 126 was amended to refer to claim 122, in view of the cancellation of claim 120. No new matter is added by the amendments.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner alleges that the claims were indefinite because “it is not clear where the binding partner [is] located.” The claims have been amended to indicate that the binding partner is coated on a surface of the microdevice. Support for this description is found on pg 14 of the application as filed. In view of the amendment, the rejection is overcome.

Rejection Under 35 U.S.C. § 103

The Examiner has maintained an obviousness rejection. The rejection is an improper rejection for reasons of record. In addition, the Examiner now alleges that the peptides, compounds, or oligonucleotides that were discussed in the cited reference “are inherent binding partners capable

of being manipulated.” This statement is inconsistent with the law on inherency: the reference provides only a vague mention of such materials, it does not describe any particular material. Not One specific material that corresponds with this binding partner was identified by the reference or by the Examiner; how can its properties be ‘inherent’? Not one compound was shown to have the property of a binding partner—the reference merely indicates that other things *could* be on the microdevice. Inherency is only a proper basis for a claim rejection where the ‘inherent’ property is necessarily present in the prior art disclosure. The Examiner has not shown that the reference discloses a compound on a microdevice; because there is no compound to consider, there can be no “necessarily present” inherent characteristics of a compound on which to base this rejection. The reference discloses only the general idea of compounds, so the Examiner cannot properly rely upon inherent properties of unidentified hypothetical compounds to support a claim rejection. The rationale for this rejection is clearly improper, and it should be withdrawn.

The Examiner included claim 122 in this rejection; however, this claim requires a “patterned magnetic material” that the Office Action does not address at all. According to the Examiner, Kaye fails to disclose a magnetic material, but it would have been obvious to use magnetic beads as taught by Wu et al. in a device according to Kaye. However, Wu does not disclose any details about its magnetic beads, and it does not disclose or suggest using a patterned magnetic material. The rejection does not even discuss how the references disclose or suggest this claim limitation, so no *prima facie* case for a rejection of this claim has been presented. Because the references do not disclose or suggest a device having the patterned magnetic material of claim 122, the rejection of this claim and each claim that depends from it is improper and should be withdrawn.

Claims 14 and its dependent claims were indicated to be allowable but for the alleged indefiniteness discussed above. Solely to avoid further expenses associated with this application, the above amendments have been made, and they overcome that objection. In addition, claim 14 has been split into two claims, claims 14 and 133, the sum of which corresponds to the scope that was indicated to be allowable as prior claim 14. The new claims 134-139 represent subject matter that was part of claim 14 and its dependent claims, and has been separated out for convenience.

In view of the amendments, the objections to the claims now presented have been overcome.
Reconsideration of the outstanding rejections is respectfully requested.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 471842000500.

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